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FINNEGAN, HENDERSON, FARABOW
GARRETT & DUNNER, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/024,496

Applicant(s)

RUBINSTENN ET AL.

Examiner

Igor Borissov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-50 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION
Response to Amendment

Amendment received on 10/18/2004 is acknowledged and entered. Claims 27 and 41 have been amended. New claims 48-50 have been added. Claims 1-50 are currently pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 27-30, 40, 42 and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27. The phrase "*memory for storing a program that accesses local information ... and generates at least one recommendation ...*" makes claim confusing, because it is not clear whether the claim directed to a computer-readable medium for storing instructions, or to the system.

Claims 28-29 are rejected as being dependent on claim 27.

Claim 30. The phrase "*a memory including a program that obtains personal information about a subject ...*" makes claim confusing, because it is not clear whether the claim directed to a computer-readable medium for storing instructions for performing a method, or to the system.

Claims 40, 42 and 45. The term "*at least in part*" makes the claims indefinite. It is not clear which part of said method is conducted in a network environment.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-26 and 32-50 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). See also MPEP 2106 II A which states that only when the claim is devoid of any limitation to a practical application "in the technological arts" should it be rejected under 35 U.S.C. 101. Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

The "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI).

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See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the

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presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test.

In the decision of *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d 1447, 1449-50 (Fed. Cir. 1999), it was recognized that not everything is statutory subject matter. The court noted that a mathematical algorithm or abstract idea is directed to non-statutory subject matter unless applied in a useful way or otherwise reduced to some type of practical application. The analysis in the *AT&T Corp* decision focused on whether or not the claimed mathematical algorithm was used to produce a useful, concrete and tangible result. AT&T's claimed process employs subscribers' and call recipients' primary interexchange carrier (PIC) indicator as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through switching and recording mechanisms to create a signal useful for billing purposes. The court noted that PIC indicator represents information about the call recipient's PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC's subscriber, and therefore, found the claimed process to comfortably fall within the scope of Section 101. *AT&T Corp.*, 50 USPQ2d 1453. Again, *AT&T Corp.* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the court in *AT&T Corp.* recognized that the claims require the use of switches and computers. In *AT&T Corp.*, the decisions of *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994) and *Arrhythmia Research Tech. Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1060, 22 USPQ2d 1033,1039 (Fed. Cir. 1992) were also cited. In *Alappat* it was held that more than an abstract idea was claimed because the claimed invention as a whole was directed toward forming a specific machine that produced the useful, concrete and tangible result of a smooth waveform display. In *Alappat*, the claimed invention was for a machine that achieved certain results and was therefore, already considered to involve the technological arts.

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In *Arrhythmia*, the court reasoned that the method claims qualified as statutory subject matter by noting that the steps transformed physical, electrical signals from one form into another form – a number representing a signal related to the patient's heart activity, a non-abstract output.

This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

The claims of the present application are distinguished from the claims analyzed in the decisions of *State Street*, *Alappat*, *Arrhythmia* and *AT&T*, where the claims in these cases clearly involved the use of technology as shown below.

State Street: The claims were in means plus function form and directed to a data processing system for managing a financial services configuration of a portfolio established as a partnership; the claims included limitations of a computer processor means for processing data, a storage means for storing data on a storage medium along with first through fifth means for processing different types of financial data. As such, the claims analyzed in *State Street* clearly involved the technological arts and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

AT&T Corp: The claims were directed to a method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber comprising generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers. In considering these claims, it is clear that technology is being used to “automatically route” calls over the facilities of interexchange carriers and generating a message record for the call. Furthermore, the courts, in analyzing these claims, clearly indicated that they recognized the claims

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require the use of switches and computers. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1450 (Fed. Cir. 1999). The court further noted that AT&T's claimed process employs subscriber's and call recipients' PICs as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through *switching and recording mechanisms* to create a signal useful for billing purposes. See *AT&T Corp. v. Excel Communications Inc.*, 50 USPQ2d at 1453 (Fed. Cir. 1999). As such, the claims analyzed in AT&T clearly involved the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Alappat: The claims were directed to a rasterizer for converting vector list data representing sample magnitudes of an input waveform into anti-aliased pixel illumination intensity data to be displayed on a display means comprising various means for determining distances and means for outputting illumination intensity data. Alappat's invention related generally to a means for creating a smooth waveform display in a digital oscilloscope and as indicated by the court, Alappat's invention is an improvement in an oscilloscope comparable to a TV having a clearer picture. The court reasoned that invention was statutory because the claimed invention was directed to a "machine". See *In re Alappat*, 31 USPQ2d at 1552-54 (Fed. Cir. 1994). Furthermore, in the decision of *AT&T Corp.*, the courts recognized that the claims in Alappat were for a machine that achieved certain results. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 50 USPQ2d at 1452 (CAFC 1999). Once again, these claims clearly involve the technological arts as recognized by the court and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Arrhythmia: The claims were directed to a method for analyzing electrocardiograph signals to determine the presence or absence of a predetermined level of high frequency energy in the late QRS signal including the step of converting a series of QRS signals to time segments, each segment having a digital value equivalent to the analog value of said signals at said time. In considering these claims, it is clear that technology is being used to convert a series of QRS signals to time segments having a digital value. Once again, these claims clearly involve the technological arts

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since one could not convert a signal to a time segment having a digital value without the aid of a computer or some processing device and, therefore, whether or not the claimed invention involved the technological arts was not an issue.

Contrary to the claims in the above-cited cases, in the present application, **claims 1-26 and 32-48** are completely silent with regard to technology and is purely an abstract idea or process steps that are employed completely without the use of any technology whatsoever. The claims are no more than a suggested idea of *recommending a cosmetic product based on demographic information*, and completely devoid of any means to carry out a process.

Furthermore, in accordance with MPEP 2106 (IV)(B)(2)(b) "Statutory Process Claims", not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)). The claims in the present application do not appear to satisfy either of the two conditions listed above. First, the claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the invention in the technological arts. Second, disregarding the fact that there is no computer claimed that would physically transform the data, there does not appear to be any physical transformation of data. The claims merely *determine local information based on the demographic information*, wherein said *local information* appears to be an arbitrary abstract thing and not a discrete value resulting from a calculation of certain parameters by a computer or processor. As per *determining* step, it may be understood as merely accessing database without transforming the data. However, the claimed invention must utilize technology in a non-trivial manner (*Ex parte Bowman*, 61 USPQ2d 1665, 1671

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(*Bd. Pat. App. & Inter. 2001*)). Although Bowman is not precedential, it has been cited for its analysis.

Thus, there neither appears to be any physical transformation of data from one form to another, which is based upon an algorithm or a calculation by a computer or processor, nor is there any technology claimed that would be used to transform the data.

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

Claim Rejections - 35 USC § 102

The following is a quotation of 35 U.S.C. 102(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being anticipated by Maloney et al. (WO 01/18674) (Maloney).

Maloney teaches a computer-implemented method and system for providing a customized product combination to a consumer, comprising:

Claim 25. Obtaining personal information about a consumer, the personal information including at least demographic information about the consumer (delivering a product to the customer inherently indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); generating a list of a plurality of cosmetic products for the consumer; receiving from the subject a request for cosmetic advice; accessing local information (water hardness, pH level) based on the geographic area (P. 10, L. 7-8; P. 11, L. 11-12); generating at least one recommendation for use of

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at least one cosmetic product based on the personal information and the local information (P. 7, L. 14-15).

Claim 26. Said method, wherein receiving the request occurs via a network and in at least one location remote from a location of the consumer (P. 4, L. 7-10).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9, 11-18, 20-24 and 27-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Fox et al. (US 5,796,932) Fox.

Maloney teaches a computer-implemented method and system for providing a customized product combination to a consumer, comprising:

Claims 1 and 27. Obtaining personal information about a consumer, the personal information including at least demographic information about the consumer (delivering a product to the customer obviously indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (environmental data including water hardness and pH level) corresponding to the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14-15; P. 7, L. 11-13).

Maloney does not specifically teach that said local information is determined *based on* said demographic information.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including

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collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include determining and predicting local weather conditions based on local information, as disclosed in Fox, because it would advantageously allow to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

Claim 2. Fox teaches said method and system, wherein said local information includes weather forecast (C. 13, L. 3-8).

Claim 3. Obtaining information about recent purchases of cosmetic products from each consumer, and having address information of said each consumer inherently indicates obtaining data on cosmetic usage of others located in the geographic area of the subject (Maloney; P. 12, L. 17-18).

Claim 4. Fox teaches said method and system, wherein said local information includes weather forecast including temperature, precipitation and snowfall (C. 6, L. 13-14), thereby obviously indicating *air quality data*.

Claims 5, 11 and 46. Fox teaches said method and system, wherein said local information includes historical and actual weather conditions and predicted weather forecast including temperature, precipitation and snowfall (C. 6, L. 13-14), thereby obviously indicating *climate data for the geographic area*.

Claims 6. Obtaining local water hardness and pH level information inherently indicates obtaining ecological data for the geographic area of the subject (Maloney; P. 10, L. 7-8; P. 11, L. 11-12).

Claim 7. Said method, wherein the personal information further includes lifestyle (Maloney; P. 7, L. 2).

Claim 8. Said method, wherein the lifestyle information includes at least one of fashion preferences, clothing color preferences, and cosmetic preferences (Maloney; P. 11, L. 27-30).

Claim 9. Said method, wherein the physical characteristics information includes at least one of age, a skin condition, skin tone, a propensity to tan, hair color, and facial feature characteristics (Maloney; P. 7, L. 1-3).

Claim 12. Receiving over a network, at a site remote from the subject, the personal information about the subject, and transmitting the recommendation to the consumer over the network (Maloney; P. 4, L. 7-10).

Claim 13. Generating recommendation based on physical characteristics information, the local information, and the variable preference information (Maloney; P. 4, L. 18-23).

Claims 14 and 28. Said method, wherein the variable preference information includes an identification of clothing that the subject intends to wear (P. 7, L. 16-19). Information as to a *suggestion to use at least one product complementary to the identified clothing* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Maloney and Fox would be performed the same regardless the content of the recommendation.

Claim 15. Said method, wherein the identification of clothing is a color of clothing (Maloney; P. 7, L. 16; P. 11, L. 28).

Claims 16 and 29. Said method, wherein the product is a cosmetic product for adding color to a face of the subject (Maloney; P. 11, L. 28; P. 12, L. 2-3).

Claims 17-18. Accessing the node prior to the time of intended cosmetic application (See claim 1). Information as to *immediately prior, or in an evening before,*

or in a day of intended cosmetic application is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 20. Obtaining information about recent purchases of cosmetic products from a consumer inherently indicates receiving from the consumer an identification of products at the subject's disposal (P. 12, L. 17-18). Information as to *immediate* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

Claim 21. Said method, wherein the physical characteristics information includes at least one of color, tone, texture, elasticity, oiliness, and pH of at least one of the subject's hair and skin (Maloney; P. 11, L. 9-10).

Claims 22-24. See reasoning applied to claim 1.

Claim 30. Maloney teaches said system for providing beauty advice, the system comprising: a memory including a program that obtains personal and geographic area location information about a consumer (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determines local information (water hardness, pH level) corresponding to the location information (P. 10, L. 7-8; P. 11, L. 11-12); generates and presents at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14-15); and a processor that runs the program (P. 14, L. 3-12).

Maloney does not specifically teach that said local information is determined *based on* said demographic information.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location)

information (C. 13, L. 3-8). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include predicting local weather conditions based on local information functionality, as disclosed in Fox, because it would advantageously allow to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

Claim 31. Maloney teaches a computer-readable medium containing instructions for causing a computer to perform said computer-implemented method for providing beauty advice, the method comprising: obtaining personal information and geographic area location information about a consumer (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (water hardness, pH level) corresponding to said local information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14, L. 3-15).

Maloney does not specifically teach that said local information is determined *based on* said demographic information.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include determining and predicting local

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weather conditions based on local information, as disclosed in Fox, because it would advantageously allow to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

Maloney teaches a computer-implemented method and system for providing a customized product combination to a consumer, comprising:

Claim 32. Maintaining a plurality of consumer categories (P. 9, L. 33-35); obtaining personal information about a consumer, the personal information including at least demographic information about the consumer (delivering a product to the customer obviously indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (environmental data including water hardness and pH level) corresponding to the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14-15; P. 7, L. 11-13).

Maloney does not specifically teach that said local information includes weather forecast for the geographic area.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include that said local information includes weather forecast for the geographic area, as disclosed in Fox, because it would advantageously allow to utilize forecasted weather conditions (e.g., temperature

and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

Claim 33. Presenting the recommendations to a user (P. 15, L. 5-12). Information as to “*beauty consultant*” is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. See: *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed. The method steps, disclosed in Maloney and Maeng would be performed the same regardless who is the user.

Furthermore, Maloney teaches:

Claim 34. Presenting includes organizing recommendations by category (P. 7, L. 5-13).

Claim 35. Obtaining information about recent purchases of cosmetic products from each consumer, and having address information of said each consumer obviously indicates obtaining data on cosmetic usage of others located in the geographic area of the subject (P. 12, L. 17-18).

Claim 36. Said method, wherein the personal information further includes lifestyle (P. 7, L. 2).

Claim 37. Said method, wherein the physical characteristics information includes at least one of age, a skin condition, skin tone, a propensity to tan, hair color, and facial feature characteristics (P. 7, L. 1-3).

Claim 38. See reasoning applied to claim 32.

Claim 39. Generating recommendation based on physical characteristics information, the local information, and the variable preference information (P. 4, L. 18-23).

Claim 40. Said method conducted in a network environment (P. 16, L. 20-34).

Claim 41. Maloney teaches said method, comprising:

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obtaining demographic information about the consumer (delivering a product to the customer obviously indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (water hardness, pH level) corresponding to said local information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product in the geographic area based on the local information (P. 7, L. 14, L. 3-15).

Maloney does not specifically teach that said local information is determined *by manipulating said received demographic* information.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information by manipulating said demographic (location) information (C. 13, L. 3-8; C. 18, L. 56 – C. 19, L. 5). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include said determining local weather conditions by manipulating said local information, as disclosed in Fox, because it would advantageously allow to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

Claim 42. Said method conducted in a network environment (Maloney; P. 16, L. 20-34).

Claim 43. Maloney teaches said method, comprising:

obtaining personal information about a consumer, the personal information including at least demographic information about the consumer (delivering a product to the customer inherently indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (water hardness, pH

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level) corresponding to the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating at least one cosmetic analysis based on at least one of the personal information and the local information and presenting the at least one cosmetic analysis (P. 7, L. 14-15).

Maloney does not specifically teach that said local information is determined *based on* said demographic information.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), and determining local weather information based on said demographic (location) information (C. 13, L. 3-8). Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include determining and predicting local weather conditions based on local information, as disclosed in Fox, because it would advantageously allow to utilize local actual and forecasted weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

Claim 44. See reasoning applied to claim 43.

Claim 45. Conducting said method in a network environment (Maloney; P. 16, L. 20-34).

Claim 47. See reasoning applied to claim 43.

Claim 48. Fox teaches determining local information by manipulating the demographic information (C. 13, L. 3-8; C. 18, L. 56 – C. 19, L. 5).

Maloney teaches a computer-implemented method and system for providing a customized product combination to a consumer, comprising:

Claim 49. Maloney teaches said method, comprising:

obtaining personal information about a consumer, the personal information including at least demographic information about the consumer (delivering a product to the customer obviously indicates obtaining a geographical location of the consumer) (P. 6, L. 30 – P. 7, L. 3; P. 11, L. 18); determining local information (environmental data including water hardness and pH level) corresponding to the demographic information (P. 10, L. 7-8; P. 11, L. 11-12); generating and presenting at least one recommendation for use of at least one cosmetic product based on at least one of the personal information and the local information (P. 7, L. 14-15; P. 7, L. 11-13).

Maloney does not specifically teach that said local information is determined *based on said demographic information and historical information associated with said area*.

Fox teaches a computer-implemented method and an interface for analysis of weather impact on a retail, personal care industry (C. 7, L. 65 - C. 8, L. 1), including collecting demographic (location) information about consumers (C. 9, L. 1-2, 19-22), providing a historical weather information for various regions; accessing and determining local weather information based on said demographic (location) information and historical weather information for said geographical region (C. 13, L. 3-8).

Furthermore, Fox teaches that weather is a local phenomenon rather than a national phenomenon, and providing interface which determines and predicts local weather conditions based on determined location information can predict the impact of weather on sales of goods (C. 4, L. 10-11, 58-61).

Therefore, it would have been obvious to one having ordinary skill in art the time the invention was made to modify Maloney to include determining local information based on said demographic information and historical information associated with said area, as disclosed in Fox, because it would advantageously allow to utilize local actual and historical weather conditions (e.g., temperature and humidity) in planning of sales and advertising of personal care products, thereby maximize profits.

Claim 50. Fox teaches projecting local (weather) information based on the demographic (geographical) information and the historical (weather) information (C. 6, L. 12).

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Fox and further in view of Anderson (US 2002/0082869).

Claim 10. Maloney and Fox teach all the limitations of claim 10, except that family history information includes historical physical characteristics information about relatives of the consumer.

Anderson teaches a computer-implemented method and system for providing and updating customized health care over the Internet, wherein personal data of an individual includes age and medical history of the individual's relatives [0016].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney and Fox to include that said family history information includes historical physical characteristics information about relatives of the consumer, as disclosed in Anderson, because it would advantageously allow to determine and exclude certain beauty product ingredients which may cause negative health conditions or even diseases to which the consumer may have a predisposition.

Claim 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney in view of Fox and further in view of Official Notice.

Claim 19. Maloney teaches all the limitations of claim 19, except that suggesting that the consumer maintain a stock of the plurality of cosmetic products.

Official notice is taken that it is well known that there are a lot of consumers have a habit to use cosmetic product every day.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include: suggesting that the consumer maintain a stock of the plurality of cosmetic products, because without maintaining said stock the consumer may run out of cosmetic product when she/he heeded it most.

Response to Arguments

Applicant's arguments in respect to claims 1-47 were fully considered but are moot in view of new ground of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (703) 305-4649.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 872-9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (703) 308-2702.

Any response to this action should be mailed to:

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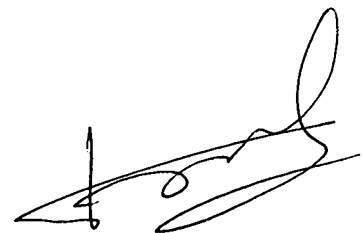
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or faxed to:

(703) 872-9306 [Official communications; including After Final
communications labeled "Box AF"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Igor Borissov
Patent Examiner
Art Unit 3629



IB

2/05/2005